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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,141	07/09/2001	Naoaki Kataoka	2001-0978	6498

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EXAMINER

BEISNER, WILLIAM H

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 09/30/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,141

Applicant(s)

KATAOKA ET AL.

Examiner

William H. Beisner

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 1899 and 26 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-69 is/are pending in the application.
- 4a) Of the above claim(s) 44,48-52,59,60,62-64 and 66-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-43,45-47,53-58,61 and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/355,891.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 March 2003 has been entered.

Election/Restrictions

2. Claims 44, 48-52, 56, 59, 60, 62-64 and 66-69 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 17.

3. Applicant's election with traverse of species i) in Paper No. 17 is acknowledged. The traversal is on the ground(s) that claim 56 which was grouped by the examiner into species i) is readable on species ii). As a result, Applicants are of the position that species i) and ii) should be examined together since species i) is generic to species ii). Applicants' comments are not found to be persuasive because the limitations of claim 56 include "reduced iron" which is not readable on species ii).

4. The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

Art Unit: 1744

5. Applicant is advised that should claim 46 be found allowable, claim 56 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 41-43, 45-47, 53-58, 61 and 65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 41 and 53 include the claim limitation that the “oxidation reduction potential of the contaminated matter reduced is maintained at not more than -350mV for at least 5 days by adding the reducing agent and the nutritional liquid”. This claim limitation was not provided in the originally filed set of claims.

In the amendment filed including this claim language, Applicants stated that support for this claim language is based on Examples 5-8 of the instant specification (See applicants’ response filed 30 May 2002).

Art Unit: 1744

Review of these examples fails to adequately support this claim language for the following reasons:

First, Examples 6 and 8 are drawn to embodiments that do not even include the use of a water-soluble organic nutritional liquid. It would not be readily apparent to one of ordinary skill in the art how the disclosure of examples 6 and 8 would provide support for the instant claim language that would require that the “oxidation reduction potential of the contaminated matter reduced is maintained at not more than -350mV for at least 5 days by adding the reducing agent and **the nutritional liquid**”.

Second, with respect to the claim language “at least 5 days”, it is not clear how any of these examples provides support for this claim limitation. While these examples establish what the ORPs are for the specific samples after a period of 63 days (See Example 5), nothing in these examples establishes the limitation “at least 5 days”. Example 6 shows -500mV for 10 days, -450mV for 10 days and -400mV for 5 days.

Third, with respect to the claim language “-350mV”, it is not clear how this claim limitation is supported by any of the examples, especially when linked with the language “at least 5 days”.

Response to Arguments

8. Applicant's arguments filed 28 March 2003 have been fully considered but they are not persuasive.

With respect to the 35 USC 112, first paragraph, rejection above concerning new matter in the claims, Applicants have provided the following comments to rebut this rejection:

Art Unit: 1744

Applicants first argue that Examples 6, 7, 8 support rapid decrease of ORP to below -350mV in a short period of time.

These comments are not found to be persuasive because Examples 6 and 8 do not even involve the use of a nutritional liquid. With respect to Example 7, while this example (system 2) uses a nutritional liquid, there is nothing in this Example that supports -350mV or at least 5 days.

With respect to the references filed to establish what would have been obvious to one of ordinary skill in the art, the use of these references are not persuasive because they are dated after the filing date of the application. The limitations need to be enabled at the time of filing of the application.

With respect to establishing the use of -350mV as a claim limitation, Applicants provide a number of Examples in the specification that allegedly support this claim language (See pages 10 and 11 of applicants' response filed 26 March 2003). While the specific examples recited support numbers such as -375mV, it is not clear how one of ordinary skill in the art would be able to determine that -350mV is the critical value in the presence of values such as -347mV which did not provide the desired result (See Example 5).

Finally, it is not clear how any of these comments clearly links -350mV with the additional claim limitation of "at least 5 days". Also it is not clear which of the Examples that include the use of both a reducing agent and nutritional liquid provide the desired degradation in a period of 5 days. The only example that mentions 5 day does not involve the use of a nutritional liquid.

For these reasons, the Examiner is of the position that the instant claim language "oxidation reduction potential of the contaminated matter reduced is maintained at not more than

Art Unit: 1744

-350mV for at least 5 days by adding the reducing agent and the nutritional liquid” constitutes new matter.


With respect to the prior art rejections of record, Applicants’ comments are persuasive to overcome the 35 USC 103 rejections of record.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 703-308-4006. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:40am to 4:10pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Robert J. Warden can be reached on 703-308-2920. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


William H. Beisner
Primary Examiner
Art Unit 1744

WHB